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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,810	11/27/2001	Jay S. Walker	01-050	1237
22927	7590	04/06/2006	EXAMINER	
WALKER DIGITAL 2 HIGH RIDGE PARK STAMFORD, CT 06905			SHERR, CRISTINA O	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,810

Applicant(s)

WALKER ET AL.

Examiner

Cristina Owen Sherr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-9,17,30-34,51-61,76-82 and 84-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-9,17,30-34,51-61,76-82 and 84-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 13, 2006 has been entered.

Status of the Claims

2. Claims 1, 2, 9, and 76 have been amended. Claims 3-5, 10-16, 18-29, 35-50, 62-75, and 83 have been canceled. Claims 84-91 have been newly added. Claims 1-2, 6-9, 17, 30-34, 51-61, 76-82, and 84-91 are currently pending in this case.

Response to Arguments

3. Applicants arguments claim that the double patenting rejection of claims 1-61 and 76-82 has been overcome, through the filing of a Terminal Disclaimer. No such Terminal Disclaimer is to be found, in this file, however. The filing of a new Terminal Disclaimer is requested with apologies for inconvenience caused to the Applicant. For the time being, the double patenting rejections have not been overcome. Additionally, Applicant's arguments with respect to the art rejections of claims 1-191 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 6-9, 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (WO 97/28510), further in view of Rothschild et al (US 5,802,015).

6. Regarding Claims 1, 9, 14

Smith et al disclose an apparatus for dispensing a product from a vending machine that includes a device in communication with the vending machine (Figure 1), storing product information and identifiers in a database (Page 20, lines 15-20; Page 31, lines 34-36), receiving at the processor a selection of the first product from a purchaser and if the first product is not available, offering a substitute product to the purchaser (Page 6, lines 5-20; Page 7, lines 1-10; Page 26, lines 7-14; Page 27, lines 21-24) and dispensing the substitute product (Page 19, lines 21-27). Smith et al does not explicitly teach that the machine stores or retrieves a substitute product identifier for a substitute product, however, in order for the machine to know which products to offer as alternative products for user selections that are not available, it would be necessary to store product identifiers for products that are substitutes or alternatives to other products. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention that the vending machine taught by Smith et al would store substitute product identifiers for products that would be substitutes to primary products

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selected by the user so that the machine would know which substitute products to offer the user if the user's primary selection is not available or out of stock. Smith further does not specifically look at expiration dates. However, it would be obvious that expiration date is a factor in availability of a product. Note that these claims do not incorporate all the limitations with respect to expiration dates describes in claim 13, now canceled. Additionally, indicators of expiration dates of products, as in Rothschild et al (e.g. abstract,) are well-known, and it would be obvious to include such as indicator in determining availability of a product.

7. Regarding claim 2

Smith et al further disclose receiving an amount of money from a purchaser (Page 10, lines 7-11; Page 11, lines 18-23; Col. 14, lines 11-25).

8. Regarding claim 6

Smith et al further disclose determining the availability of the first product (Page 6, lines 5-20; Page 7, lines 1-10; Page 26, lines 7-14; Page 27, lines 21-24).

9. Regarding claim 7

Smith et al further disclose recording a value corresponding to the selection of the first product (Page 8, lines 5-36; Page 26, lines 2-15; Page 35, lines 30-38).

10. Regarding claim 8

Smith et al further disclose wherein the value includes one of a first product identifier corresponding to the first product, a timer the first product was selected, a date the first product was selected and an availability of the first product (Page 8, lines 5-36; Page 26, lines 2-15; Page 35, lines 30-38).

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11. Regarding claim 17

Smith et al further disclose offering the substitute product to the consumer at a discounted price (Page 11, lines 5-11; Page 26, lines 26-33).

12. Regarding claims 30-31

Smith et al further disclose wherein the first product and the substitute product is a service (Page 8, lines 15-38; Page 11, lines 31-35; Page 12, lines 22-30; Page 14, lines 10-15).

13. Claims 32-34, 51-52, 76-82, and 84-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al, WO 97/28510, published 07 August 1997, in view of Levasseur, U.S. Patent No. 5,029, 098.

14. Regarding claims 32 and 84-91

Smith et al fails to explicitly disclose determining substitute products for a first product and storing for the first product, a substitute product identifier corresponding to the substitute product, however, in order for the machine to know which products to offer as alternative products for user selections that are not available, it would be necessary to store product identifiers for products that are substitutes or alternatives to other products. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention that the vending machine taught by Smith et al would store substitute product identifiers for products that would be substitutes to primary products selected by the user so that the machine would know which substitute products to offer the user if the user's primary selection is not available or out of stock. Smith et al further disclose a computerized method of dispensing a product from a vending machine that

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includes a processor comprising measuring a demand for each of a plurality of products stored in the machine (Page 8, lines 5-36; Page 26, lines 215; Page 35, lines 30-38), however, Smith et al fail to specifically disclose that the substitute product is determined based on a measure of demand for a plurality of products. Levasseur discloses a vending machine that monitors the historical demand over a period of time for various classes of selectable vendable products and allocating the space within the vending machine based on the historical demand (Abstract). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Smith et al and store product identifiers corresponding to substitute products based on demand since a customer will likely purchase a substitute product that has a high demand.

15. Regarding claim 33

Smith et al disclose an apparatus for dispensing a product from a vending machine that includes a device in communication with the vending machine (Figure 1), storing product information and identifiers in a database (Page 20, lines 15-20; Page 31, lines 34-36), receiving at the processor a selection of the first product from a purchaser and if the first product is not available, offering a substitute product to the purchaser (Page 6, lines 5-20; Page 7, lines 1-10; Page 26, lines 7-14; Page 27, lines 21-24) and dispensing the substitute product (Page 19, lines 21-27). Smith et al does not explicitly teach that the machine stores or retrieves a substitute product identifier for a substitute product, however, in order for the machine to know which products to offer as alternative products for user selections that are not available, it would be necessary to

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store product identifiers for products that are substitutes or alternatives to other products. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention that the vending machine taught by Smith et al would store substitute product identifiers for products that would be substitutes to primary products selected by the user so that the machine would know which substitute products to offer the user if the user's primary selection is not available or out of stock.

16. Regarding claim 34

Smith et al further disclose offering the substitute product to the consumer at a discounted price (Page 11, lines 5-11; Page 26, lines 26-33).

17. Regarding claims 51-52

Smith et al further disclose wherein the first product and the substitute product is a service (Col. 8, lines 15-38; Col. 11, lines 31-35; Col. 12, lines 22-30; Col. 14, lines 10-15).

18. Claims 76-81 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,324,520 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other. Smith et al further disclose wherein the device is operable to receive data via the network and display to a purchaser data received via the network (Figure 1; Col. 9, lines 14-38; Col. 17, lines 1-30). Please note that claim 80 appears to depend from itself. For purposes of examination, claim 80 is being read as depending on claim 79. Appropriate correction is required.

19. Regarding claim 82

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Smith et al further disclose receiving input from a purchaser via a touch screen (Page 23, lines 1-10).

Double Patenting

20. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

21. A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

22. Claims 1-2, 6-9, 17, and 30-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,324,520 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other.

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23. Claim 1 of U.S. Patent No. 6,324,520 B1 recites all the limitations of claim 1 of the present application, however, Claim 1 of U.S. Patent No. 6,324,520 B1 differs since it further recites additional claim limitations including detecting a purchaser, measuring a time between a detection and a receipt of the amount of money from the purchaser and storing a value corresponding to the time. However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent No. 6,324,520 B1 by removing the limitations directed to the detection of a purchaser and measuring the time resulting generally in the claims of the present application since the claims of the present application and the claim recited in U.S. Patent No. 6,324,520 B1 actually perform a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art. Claims 2, 6-9, 17, and 30-31 2-31 depend upon claim 1 and are rejected for the same reasons.

24. Claims 32-34, 51-52, and 84-91 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 25 of U.S. Patent No. 6,324,520 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other.

25. Claim 25 of U.S. Patent No. 6,324,520 recites all the limitations of claim 32 of the present application, however, Claim 25 of U.S. Patent No. 6,324,520 131 differs since it further recites additional claim limitations including determining an average selection

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time and dispensing the substitute product. However, it would have been obvious to a person of ordinary skill in the art to modify claim 25 of U.S. Patent No. 6,324,520 131 by removing the limitations directed to determining an average selection time resulting generally in the claims of the present application since the claims of the present application and the claim recited in U.S. Patent No. 6,324,520 B1 actually perform a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art. Claims 33-34, 51-52, and 84-91 depend upon claim 32 and are rejected for the same reasons.

26. Claims 53-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 37 of U.S. Patent No. 6,324,520 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other.

27. Claim 37 of U.S. Patent No. 6,324,520 131 recites all the limitations of claim 53 of the present application, however, Claim 37 of U.S. Patent No. 6,324,520 1311 differs since it further recites additional claim limitations including a detector device means. However, it would have been obvious to a person of ordinary skill in the art to modify claim 37 of U.S. Patent No. 6,324,520 B1 by removing the limitations directed to the detector device means resulting generally in the claims of the present application since the claims of the present application and the claim recited in U.S. Patent No. 6,324,520

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actually perform a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963). Also note Ex pane Rainu, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art. Claims 54-61 depend upon claim 53 and are rejected for the same reasons.

28. Claims 76-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,324,520 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other.

29. Claim 1 of U.S. Patent No. 6,324,520 B1 recites all the limitations of claims 76 and 83 of the present application, however, Claim 1 of U.S. Patent No. 6,324,520 B1 differs since it further recites additional claim limitations including detecting a purchaser, measuring a time between a detection and a receipt of the amount of money from the purchaser and storing a value corresponding to the time. However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent No. 6,324,520 B1 by removing the limitations directed to the detection of a purchaser and measuring the time resulting generally in the claims of the present application since the claims of the present application and the claim recited in U.S. Patent No. 6,324,520 B1 actually perform a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963). Also note Ex pane Rainu, 168

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USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art. Claims 77-82 depend upon claim 76 and are rejected for the same reasons.

30. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

32. Levasseur [4,359,147] discloses a means to control vending functions and teaches the capability for the customer to make alternate selections when the primary selection is not available

33. Paganini et al disclose a method and apparatus for detecting the presence and movement of a user within a defined area in the proximity of a user device or teller machine

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34. Levasseur [4,478,353] discloses a vendor control system and teaches the capability for the customer to make alternate selections when the primary selection is not available

35. Abraham et al disclose a system that checks brands of articles in a vending machine which are being dispensed more frequently indicating a higher demand for those articles

36. Hayashi et al disclose a control and monitoring apparatus for vending machines and teach monitoring sales management data to determine the number of products sold to understand customer demand for products.

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

COS
03/28/06

Shella Anne S
PRIMARY EXAMINER